

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Harold R. Garner  
Serial No: Continuation of 09/326,526  
Filing Date: Concurrently herewith  
Group/Art Unit: 2872  
Examiner: Phan, J.  
Title: DIGITAL OPTICAL CHEMISTRY MICROMIRROR IMAGER

Commissioner for Patents  
Washington, D.C. 20231

**DECLARATION UNDER 37 C.F.R. § 1.131 OF PRIOR INVENTION IN THE UNITED STATES TO OVERCOME CITED REFERENCE**

**Purpose of Declaration**

1. This declaration is to establish completion of the invention, which is the subject of the Continuation of Patent Application Serial No. 09/326,526, filed June 4, 1999, entitled "DIGITAL OPTICAL CHEMISTRY MICROMIRROR IMAGER," which claims priority to Provisional Patent Application Serial No. 60/087,948, filed June 4, 1998 in the United States at a date prior to February 1998, which is the date of the prior art cited by the Examiner in the Office Action mailed January 2, 2001.
2. The person making this declaration is the inventor.
3. The Board of Regents, The University of Texas System is the owner of the patent application by Assignment dated June 3, 1998, recorded on June 4, 1998 at reel 9217, frame 0897.

**Facts and Documentary Evidence**

4. To establish the date of completion of the invention of this application, the following copies of a presentation related to a grant application is attached hereto as Exhibit A and submitted as evidence. The photograph in Exhibit A was taken in August 1997 and demonstrates that the device as claimed had been built and was operating prior to the filing date of the reference cited as prior art in the parent application of this filing. Exhibit A, attached hereto, demonstrates that the device as claimed had been not only conceived but reduced to practice

before the filing date of the art cited in the parent application. Furthermore, this affidavit in conjunction with the affidavit under 37 C.F.R. § 1.131 filed in the parent application demonstrated that the device was used to form a mask pattern formed and printed using the present device, and was therefore reduced to practice in the United States prior to the filing date of the art used the for rejection.

5. From the lab notebook pages attached hereto as Exhibit A, it can be seen that the invention in this application was used to produce a mask pattern on a substrate on the date even therewith, which is on or before February 23, 1998, which is a date earlier than the effective date of the reference cited in the parent application.

#### **Time of Presentation of the Declaration**

6. This declaration is submitted prior to final rejection.

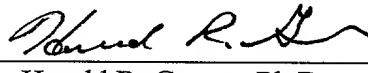
#### **Declaration**

7. As a person signing below:

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

#### **Signature**

Date: 11/28/01

By:   
Harold R. Garner, Ph.D.  
as named inventor.

Residence address:  
4100 Post Oak Road  
Flower Mound, Texas 75028

Business address:  
5323 Harry Hines Blvd, Mail Station 8591  
Dallas, Texas 75390-9094

DECLARATION AND POWER OF ATTORNEY FOR PATENT APPLICATION

As a named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled "Digital Optical Chemistry Micromirror Imager" the specification of which

(check one) X is attached hereto.

           was filed on                                  as Application Serial No.                                  and  
was amended on                                 .  
(if applicable)

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, § 1.56(a).

I hereby claim foreign priority benefits under Title 35, United States Code, § 119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application of which priority is claimed:

Prior Foreign Application(s)		Priority Claimed
<u>                                </u> (Number)	<u>                                </u> (Country)	<u>                                </u> (Day/Month/Year Filed)
<u>                                </u> (Number)	<u>                                </u> (Country)	<u>                                </u> (Day/Month/Year Filed)

I hereby claim the benefit under Title 35, United States Code, § 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States Application in the manner provided by the first paragraph of Title 35, United States Code, § 112, I hereby acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, § 1.56(a) which occurred

between the filing date of the prior application and the national or PCT international filing date of this application:

_____ (Appl.Ser.No.)	_____ (Filing Date)	_____ (Status) (Patented, pending, abandoned)
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POWER OF ATTORNEY: As a named inventor, I hereby appoint the following attorney(s) jointly and severally to prosecute this application and transact all business in the Patent and Trademark Office connected therewith and to file any and all International Application(s) with respect thereto and to act on my behalf before the competent International Authorities with respect thereto: Sanford E. Warren, Jr. (Reg. No. 33,219); Daniel F. Perez (Reg. No. 33,755); Lawrence R. Youst (Reg. No. 38,795); Edwin S. Flores (Reg. No. 38,453).

SEND CORRESPONDENCE TO:

Daniel F. Perez  
Gardere & Wynne, L.L.P.  
1601 Elm Street, Suite 710  
Dallas, TX 75201-4761

DIRECT TELEPHONE CALLS TO:

Daniel F. Perez  
(214) 696-8183  
(214) 696-8191 (FAX)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of sole inventor: Harold R. Garner, Ph.D.

Inventor's signature Harold R. Garner, Ph.D. June 3, 1998  
Date

Residence: 4100 Post Oak Road  
Flower Mound, TX 75028

Citizenship: United States

Post Office Address 4100 POST OAK ROAD  
FLOWER MOUND, TX 75028

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ASSIGNMENT

WHEREAS, Harold R. Garner, Ph.D., has made an invention entitled "Digital Optical Chemistry Micromirror Imager" for which he has executed Letters Patent of the United States of even date herewith;

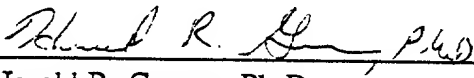
WHEREAS, BOARD OF REGENTS, THE UNIVERSITY OF TEXAS SYSTEM, having its principal office at 201 West Seventh Street, Austin, Texas 78701 (hereinafter referred to as "Assignee") desires to acquire the entire right, title and interest in, to and under the above invention and application and any patents which may be granted on said invention in the United States and in any and all foreign countries;

NOW, THEREFORE, for good and valuable consideration, the receipt and adequacy of which one hereby acknowledged, we do sell, assign, and transfer, and by these presents do sell, assign and transfer unto Assignee, the full and exclusive right, title and interest in and to any and all patents which may be granted therefor in the United States and its territorial possessions and in any and all foreign countries and to any and all divisions, reissues, continuations and extensions thereof.

I hereby authorize and request the Patent Office of the United States and any and all foreign countries to issue any and all of said patents, when granted to Assignee as the Assignee of my entire right, title and interest in and to the same, for the sole use and enjoyment of Assignee, its successors and assigns.

Further, we agree that we will communicate to Assignee, or its representatives, any facts known to me respecting said invention, and testify in any legal proceedings, sign all lawful papers, execute all divisions, continuation, substitution, renewal and reissue applications, execute all necessary papers to cause any and all of said patents to be issued to Assignee, make all rightful oaths and generally do everything necessary or desirable to aid Assignee, its successors and assigns, to obtain and enforce proper protection for said invention in the United States and in any and all foreign countries.

IN TESTIMONY WHEREOF, I have hereunto set my hand and affixed my seal this 3rd day of June, 1998.

  
\_\_\_\_\_  
Harold R. Garner, Ph.D.

DECLARATION AND POWER OF ATTORNEY FOR PATENT APPLICATION

As a named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled "Digital Optical Chemistry Micromirror Imager" the specification of which

(check one)  X  is attached hereto.

-  was filed on \_\_\_\_\_ as Application Serial No. \_\_\_\_\_ and  
was amended on \_\_\_\_\_  
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